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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/633,937	08/08/2000	Patrick Egan	20181-2	4122

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EXAMINER

NGUYEN, CHI Q

ART UNIT PAPER NUMBER

3635

DATE MAILED: 12/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/633,937

Applicant(s)

EGAN, PATRICK

Examiner

Chi Q Nguyen

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 24-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 22.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This Office action is in response to the applicant's amendment filed on 9/22/03.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Balla-Goddard (US 5,743,056) in view of Beier (US 5,836,628).

Balla-Goddard discloses building panel comprising a first, exterior, a second, interior facing sheets of generally rigid material 56, and having a first, a second, thickness, and a first, a second sheet perimeter, respectively; at least two framing struts 60 being located between the first and second sheets and having struts thickness to define a panel volume between the first, second sheets, and framing struts, a layer of polymeric in-situ foam core 58 comprising polyurethane located in and substantially filling the panel volume, a sheet of drywall 52 having a drywall thickness and adjacent the interior facing sheet 56, the drywall having an interior surface, a trim piece 208, a jamb member 206, service ducts 103 are located between the plaster board or drywall 52 and the panel 16 for electricity cables, telephone lines; server pipes and/or gas pipes, a window opening (col. 7, lines 40-43, 65-66). The panel has a first vertical side edge having a male projection member 72 adapted to project into a corresponding

female reception member 74 on an adjacent panel (figs. 1-9). Balla-Goddard does not specifically teach an overall panel thickness including the sum of said first thickness, said overall panel thickness being between approximately  $3 \frac{3}{4}$  and  $4 \frac{1}{4}$ " and wherein the jamb thickness is substantially equal to the sum of the overall panel thickness and the drywall thickness, such that the jamb is substantially flush therewith for the trim piece to be mounted flush across the jamb and drywall without the use of furring. Beier teaches doorjamb structure comprising exterior, interior panels 16, 18, struts 14, trim pieces 34, 38, a jamb member 12 located adjacent to struts members 14 and its thickness is equal to the thickness of overall panel thickness and flush within the trim pieces 34, 36. (See fig. 1). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Balla-Goddard with Beier for teaching the jamb member having overall thickness equal to the overall thickness of the sum panel thickness so that the panel members are fully support by the trim and jamb members. However, the jamb overall thickness taught by Beier does not included a drywall sheet, examiner considers this would have been obvious to add a drywall sheet because the completed wall should included it and therefore, the jamb member will be accommodated this overall thickness of the completed wall structure. Balla-Goddard does not teach specifically the overall panel thickness between approximately  $3 \frac{3}{4}$  and  $4 \frac{1}{4}$  inches, the struts comprise wooden struts having an actual cross-sectional dimensioning about  $1 \frac{1}{2}$  by  $3 \frac{3}{16}$ ", and the thermal insulation R-value through a foam containing portion of the thickness of at least 20, the first, second sheets are each made form  $\frac{7}{16}$  thick OSB, and drywall has a thickness of  $\frac{1}{2}$ ".

It would have been obvious to one of ordinary skill in the art at the time the invention was made to choose the desirable thickness of the panel and the insulation to accommodate the opening gap is considered as an obvious design choice based on desired use.

With regards to claims 32, 40, 43, and 50, Balla-Goddard and Beier teach the structural elements for the wall panel except for the struts are wooden. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have wooden struts, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. The motivation for doing so would have been to provide lightweight wall structure. Balla-Goddard teaches a window opening between panels 32 and 30 forming the base and the top of the opening and panels 26 and 28, brackets 208 are secured to the panels around the outside opening and a wooden window frame 34 (col. 8, lines 7-9).

Claims 53-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Balla-Goddard ('056) in view of Beier ('628) and further in view of Porter ('645).

Balla-Goddard and Beier teach the structural elements for the building wall panel as stated except for at least one electrical box located between the first sheet and the second sheet. Porter teaches electrical access in structural insulated foam core panels including electrical box 42 located between first 12 and second 14 sheets (see fig. 1). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Balla-Goddard and Beier with Porter for the electrical box connected to

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the service duct 103 taught by Balla-Goddard (col. 7, lines 41-42). The motivation for doing so would have been to provide electrical outlet for occupant usage.

### ***Response to Arguments***

Applicant's arguments with respect to claims 24-56 have been considered but are moot in view of the new ground(s) of rejection.


In regard to the declaration of Mr. Patrick Egan filed on 2/11/03 with the commercial success story; the examiner had fully considered; however, it found that not persuasive because the applicant's claimed invention is ineffective to overcome the prior art taught by Balla-Goddard ('056), Beier ('628) and Porter ('645). Although, the applicant's discovered panel thickness ranges had made some commercially success over years; however, the examiner considers this would have been an obvious of design choice for a desirable application.

### ***Conclusion***

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Chi Q. Nguyen whose telephone number is (703) 605-1224, Mon-Thu (7:00-5:30), Fridays off or examiner's supervisor, Carl Friedman can be reached at (703) 308-0839. The fax number for the organization where this application or proceeding assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-

1113.

  
CQN  
12/8/03

  
Carl D. Friedman  
Supervisory Patent Examiner  
Group 3600